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08/655, 136 05/30/96 TOGNAZZINI

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EXAMINER

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07/27/98

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>08/655,136</b>	Applicant(s) <b>Bruce Tognazzini</b>
	Examiner <b>Jason Rhodes</b>	Group Art Unit <b>2762</b>

Responsive to communication(s) filed on May 11, 1998.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-20 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Response to Amendment***

1. The objection to the claims is withdrawn by the Examiner after consideration of the amendment filed May 11, 1998.
2. Applicant's arguments filed May 11, 1998 have been fully considered but they are not persuasive.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-4 and 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weiss *et al.* in view of Rosen.

### **claim 1**

Weiss discloses an apparatus for sending information to called stations over a telephone line (abstract), comprising:

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"a telephone set connected to the line." Weiss discloses a telephone set (Fig. 1) which is connected to a telephone line (abstract).

"a data interface connected to the line." Weiss discloses a modem which is connected to the telephone line (Fig. 11, and col. 10 lines 25-28) which inherently acts as a data interface.

"a card reader for reading card information and sending it to one of the called stations over the data interface." Weiss discloses a card reader (Fig. 11) for use with a smartcard (col. 6 lines 35-38). Weiss discloses that smart card may transmit information from the microprocessor of one telephone-computer to another, such as financial data and bank records (col. 10 lines 46-53). This information would include account numbers that the user would send to a bank service computer, which Weiss discloses as a possible called station (col. 23 lines 52-66).

"data memory for storing information from one of the called stations, including the card information." Weiss discloses a data memory for storing information from the called network host computer (col. 13 lines 52-67). Weiss also discloses that the card information is read into the primary microprocessor of the telephone-computer from the smartcard (col. 6 lines 35-38, and col. 10 lines 49-53) which inherently is stored in a data memory (microprocessor memory - col. 10 lines 33-39).

**claims 2-4, 18, 19**

"a docking port for receiving a portable device having device memory therein and for transferring information from the data memory to the device memory." Weiss discloses that the

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smartcard is a device which contains a data memory, and that information from the data memory can be transferred to the smartcard memory (col. 6 lines 35-38, and col. 10 lines 46-53). The card reader can therefore be interpreted as the claimed docking port. In addition, Weiss discloses parallel and serial ports which support memory storage devices (col. 8 lines 66-68).

"a display for displaying information from the data memory." Weiss discloses a display for displaying information from data memory in column 6, lines 17-25 and 59-62.

"a plurality of data memories and a corresponding plurality of keys for activating the data memories to send information stored in the data memories to another of the called stations."

Weiss discloses a plurality of programmable function keys, each of which performs a function such as outputting a set of dial tones (speed dialing) (col. 6 lines 3-6). Each key would therefore correspond to a memory location which stores the number to dial (the examiner interprets a plurality of locations in memory which contain different kinds of information as equivalent to a plurality of memories). It was well known in the art at the time the invention was made to use the programmable function keys to activate the data memories to send data to a called station because dialing numbers on a touch-tone phone is an accepted way of inputting data into automated phone systems.

"wherein the data interface, the card reader, the data memory, and key are integrated into the telephone set." Figures 7 and 8 of Weiss show that the components of the telephone computer are implemented in a telephone set. Weiss discloses that the component in the set of

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Figures 7 and 8 include a card reader and keyboard (col. 9, lines 42-49) as well as a memory and modem (col. 10, lines 16-21).

"wherein said information comprises credit card information." The examiner notes that credit card information is not given patentable weight over any kind of data because it is merely a number.

**claims 11, 20**

Weiss discloses a method of sending information related to a telephone purchase comprising the step of:

"providing an element for performing the step of storing information, including card information, received from a seller in memory located at a customer-site telephone." Weiss discloses that the data memory stores information from the network host computer (col. 13 lines 52-67), wherein the information consists of information required by a service computer of a seller (col. 23 lines 12-28 and 43-51).

"wherein said information comprises credit card information." The examiner notes that credit card information is not given patentable weight over any kind of data because it is merely a number.

**claims 13**

Weiss discloses a method of sending information related to a telephone purchase comprising the step of:

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"recording information from the customer in digital form." Weiss discloses that the user information needed by the service computer for identification and authorization is stored by the network host computer, inherently in digital form (col. 25 lines 20-41).

**claims 15-17**

Weiss discloses a system for sending and receiving orders for goods comprising:

"a telephone at a customer site having a customer memory for storing and sending information." See the abstract of Weiss.

"a telephone at a seller site having a seller memory and a display for respectively storing information, provided by the customer and keyed in by personnel at said seller site and stored in the seller memory." Weiss discloses that the seller sites (e.g., banks and airline ticket sellers - col. 24 lines 9-19) comprise service computers which is connected to a network host via telephone lines (col. 23 lines 12-28). It was well known in the art at the time the invention was made for such service computers to contain fax/modem cards enabling the computer to function as a telephone. It is inherent that the seller, such as an airline ticket seller, records the information in the service computer memory. The examiner also points out that such a memory stores information keyed into the computer. The fact that the information is keyed in by personnel is not given patentable weight over the data stored in the computer memory of Weiss.

"a telephone network connecting the telephone at a customer site with the telephone at a seller site while an order for goods is placed." Weiss discloses that the customer telephone is

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connected to the network host computer which is connected to the seller service computer via a telephone network (Fig. 19 and col. 23 lines 29-51).

**claims 1-3, 11, 13-17 are obvious over Weiss in view of Rosen**

Weiss does not disclose the sending of the information received from the called station to another called station for a second transaction. Weiss also does not disclose that the seller checking to see if the customer is equipped memory for storing the information prior to sending the information.

Rosen discloses a system for sending information related to a purchase over a communications network in which electronic money is used (abstract). Rosen discloses that a seller (issuing bank) site transfers electronic notes to a customer site (subscriber's transaction module) (col. 6 lines 48-57). The electronic notes consists of a set of data (col. 19 line 47 - col. 20 line 10) which is stored by the customer in memory (col. 13 lines 6-17). Rosen discloses that the transaction memory module can be embodied as a co-processor in a telephone connected to a network (col. 9 lines 60-65). Rosen discloses that the subscriber may be a customer, or a seller of goods and services (col. 10 lines 26-34). The customer can then send the information comprising the electronic notes to a seller (not necessarily the issuing bank) (col. 49 lines 6-18). Rosen discloses that the transaction money module contains a key for sending these electronic notes (Fig. 3 - PAY key of wallet). Rosen discloses that during a transaction between money modules, if the receiver does not respond to the transgressor's message in a specific time, perhaps due to not being properly equipped to handle the transaction, the transferring module will abort

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the transaction (col. I3 lines 44-66). Rosen also discloses that the transaction money module can comprise a portable telephone (Fig. 3 and col. 56-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the sending of electronic notes as disclosed by Rosen as the method of payment for telephone purchases in the system disclosed by Weiss because customers would not have to worry about having their credit card account numbers being intercepted by third parties or misused by sellers.

**claim 12 is obvious over Weiss in view of Rosen**

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement a portable device, as disclosed by Rosen, as the element for sending information to a seller in the system of Weiss in order to give the customer the convenience of making purchases from practically any location.

5. Claims 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Talton in view of Weiss *et al.*

**claim 5**

Talton discloses a credit card sized device for sending information to called stations over a telephone line (abstract), comprising:

"a device memory." See the abstract of Talton.

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"a converter for converting the information from the device memory into an audible representation of the information." Talton discloses retrieving means for retrieving data items from memory (claim 1), and converting means for converting the retrieved data into a sequence of audible dialing tones (claim 8).

"a send key for activating the converter; whereby, by activating the send key, the audible representation is presented to a microphone of a telephone set for transmission to at least one of the called stations." Talton discloses that the card's speaker is placed over the mouthpiece of a phone receiver and that the user can press a long distance dial key, which causes the card to present the tones to the receiver (col. 5 lines 1-7). After a programmed delay, the tones for the account number is sent (col. 5 lines 7-12).

**claims 7, 8, 10**

"the portable device of claim 5 further comprising a display for showing the contents of the device memory." See col. 4 lines 65-68 of Talton.

"the portable device of claim 5 in which the converter comprises a digital to analog converter and an electro-acoustical transducer." Talton discloses that the converting means includes a dial tone signal generating means and wave shaper means which takes the digital signals from the memory and converts them into an analog waveform (claim 9). These devices correspond to a digital to analog converter. Talton discloses an audio amplifier which for amplifying the output of the wave shaper, and a speaker driven by the amplifier (claim 9). The speaker corresponds to the electro-acoustical transducer.

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"the portable device of claim 5, further comprising a plurality of keys for entering a password prior to loading information into the device." Talton discloses a keyboard which can be used for entering a numerical password (PIN) (abstract and col. 3 lines 10-13). Talton does not explicitly disclose entering the password before loading information into the device. It would have been obvious to one having ordinary skill in the art at the time the invention was made to allow for the entering of a password before loading information in the device since it was known in the art that such devices contains personal information which a user would not want other people to have access to or to alter.

"the portable device of claim 5, further comprising a plurality of keys for entering a password prior to activating the converter." Talton discloses a keyboard (abstract and Fig. 2) and also discloses that whenever the user wants to use the card as a credit card, he must enter a password (PIN) (col. 3 lines 10-13).

**claims 5-10 are obvious over Talton in view of Weiss**

Talton does not explicitly disclose a docking port for receiving information from an external memory and loading the information into the device memory. Talton also does not disclose a plurality of memories and a plurality of keys activating the data memories to send information.

Weiss discloses a credit card sized device (smartcard) used for sending information to called stations over a telephone line (col. 29 lines 5-15) comprising a device memory (col. 10 lines 46-49). Weiss discloses user information can be transferred from the memory of a telephone-computer to the smartcard memory (col. 10 lines 46-53). The examiner interprets a

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docking port as the means for receiving information from an external memory. Therefore, the means of the smartcard which allows it to interface with the smartcard reader (col. 9 lines 42-44) is interpreted as a docking port. Weiss discloses that the smart card contains information including bank records and financial data (col. 10, lines 46-53). Bank records are inherently received from the banking service computer, which Weiss discloses as a possible called station (col. 23 lines 52-66). Weiss also discloses a plurality of programmable function keys, each of which performs a function such as outputting a set of dial tones (speed dialing) (col. 6 lines 3-6). Each key would therefore correspond to a memory location which stores the number to dial (the examiner interprets a plurality of locations in memory which contain different kinds of information as equivalent to a plurality of memories).

It would have been obvious to one of ordinary skill at the time the invention was made to implement the docking port and method of loading data disclosed by Weiss to the device of Talton in order to avoid having to type all of the phone and account numbers into the device manually.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to implement the plurality of keys for activating the sending of different kinds of information, as disclosed by Weiss, to the device of Talton in order to let the user program the keys with the most frequently used numbers and eliminate the need to look for them in memory using the scroll keys.

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***Consideration of Applicant's Remarks***

6. In the remarks, Applicant argues:

- (A) Regarding the rejection of claims 13 and 15-17, applicant argues that the claimed invention now recites the limitation “determining whether a telephone of said customer is memory equipped”. Weiss *et al.* does not teach this claimed aspect.
- (B) Regarding the rejection of claim 1-4, claim 1 recites “a key for activating said data memory to send said stored information”, where the information is defined in the claims as “information from one of said called stations, including said card information.” The Official Action does not address this limitation. After a thorough review of the prior art, none of the references taken alone or in combination, teaches or suggests this aspect.
- (C) Regarding the rejection of claim 11, there is no teaching or suggestion found in either reference for combining the computer/telephone of Weiss *et al.* with an electronic monetary system such as that disclosed in Rosen. The Action states it would have been obvious to “implement the sending of electronic notes as disclosed by Rosen as the method of payment for telephonic purchases in the system disclosed by Weiss because customers would not have to worry about having their credit card account numbers being intercepted by third parties or misused by sellers.” With respect to this rationale, it appears that some sort of authorization number, similar to a credit card number, would be required to complete the electronic transfers of Rosen. These authorization numbers would appear to be equally susceptible to the interception or misuse identified in the Action, and thus would not provide sufficient motivation for combining

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the references for this reason. Secondly the suggested modification does not render the claimed invention obvious. Claim 11 recites "storing information, including card information, received from a seller in a memory which requires "sending said information from said memory located at the customer-site telephone to a seller".

(D) Regarding the rejection of claims 5-10, claim 5 recites that the portable device comprises "a docking port for receiving information from an external memory and loading said information into said device memory, wherein said information comprises card information relating to a telephone purchase and is received from a seller memory connectable to said external memory".

Neither Talon or Weiss *et al.* teach or suggest this aspect.

***Response to Applicant's Remarks***

7. Applicant's argument in (A) with respect to claims 13 and 15-17 have been considered but are moot in view of the new ground(s) of rejection above.

8. In response to applicant's argument in (B), the examiner points out that the Official Action mailed 2/11/98 does address the limitation of "keys for activating the data memories to send information stored in the data memories to another of the called stations" on page 6, about midway down. The Action states that Weiss does disclose such a limitation. The Official Action also admits that Weiss does not disclose that the information is received from one of said called stations. However, Rosen does disclose that electronic notes can be received at a customer site

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from a seller (issuing bank) (col. 6, lines 48-57). Rosen also discloses that this information can be sent from the customer to another seller (col. 49, lines 6-18). Since Weiss discloses that card information is read into the system (col. 6, lines 35-38), and inherently stored in memory. Weiss discloses that the information from the card includes an encrypted personal identification code to be sent to a seller site in order to access a secured database (col. 29, lines 1-13). Therefore, the combination of Weiss and Rosen teaches the limitations of claim 1.

9. In response to applicant's argument in (C) that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation to combine is to ensure that customers would not have to worry about having their credit card account numbers being intercepted by third parties or misused by sellers. In response to applicant's assertion that this motivation is not sufficient because some sort of authorization numbers must be used in the Rosen reference, the examiner notes that the electronic notes of Rosen are stored on and may only be transferred from the user's money module stored in the user's computer (col. 4, lines 45-51; and col. 10, lines 26-29). Rosen discloses that the money module is tamper resistant and contains components difficult to access

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(col. 10, lines 59-65). Therefore, anyone who is able to intercept the electronic money notes identifier numbers would not be able install the notes to his own money module. A would-be thief would need access to someone else's computer in order to use electronic notes which do not belong to him, which is much more difficult than calling up a retailer and using a stolen credit card number. Therefore, the motivation for combining is sufficient. The tamper resistance of Rosen's money module would inherently be implemented in the memory device of Weiss when implementing the electronic notes.

In response to applicant's argument in (C) that the combination of Weiss and Rosen does not render the invention of claim 11 obvious, the examiner points out that Weiss teaches that information read from the smart card includes an encrypted personal identification code which is sent to financial institutions or an information service (col. 29, lines 1-25). The personal identification number inherently comes from the financial institution or information service. Since the personal identification number is received from the smart card in encrypted form, the personal identification number is interpreted as card information. It is also noted that "card information" is not given patentable weight over any other kind of data, because card information can be interpreted as merely a number. No card reader is claimed from which the card information is received. The financial institution and information services are interpreted by the examiner as sellers. Therefore the combination of Weiss and Rosen do teach "storing information, including card information, received from a seller in a memory" and "sending said information from said memory located at the customer-site telephone to a seller".

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10. In response to applicant's argument in (D), the examiner points out that Weiss discloses that information read from the smart card can includes bank records and financial data (col. 10, lines 46-53). This information would include information relating to transactions with the bank service computer which Weiss discloses as a possible called station (col. 23 lines 52-66). Such transactions can be interpreted as telephone purchases because they are transactions which are performed over the telephone lines disclosed by Weiss. The term "card information" used in claim 5 is not given patentable weight over any other type of data or number because card information is interpreted as merely a number. The limitation of the seller memory being connectable to the external memory (smart card) is very broad, and can be interpreted as being connectable via the telephone line and telephone-computer hardware of Weiss. Since Weiss discloses that information pertaining to bank records and financial data is stored in the card, the card must somehow be connectable to the bank service computer.

### *Conclusion*

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Rhodes whose telephone number is (703) 305-3942.



ALLEN R. MACDONALD  
SUPERVISORY PATENT EXAMINER

Jason Rhodes

July 20, 1998